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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,171	02/02/2004	Ichiro Kataoka	62758-069	6032
7590 09/13/2005 McDermott, Will & Emery 600, 13th Street, N.W. Washington, DC 20005-3096			EXAMINER RAO, SHEELA S	
			ART UNIT 2125	PAPER NUMBER

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,171

Applicant(s)

KATAOKA ET AL.

Examiner

Sheela Rao

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/2/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-5 are pending and presented for examination.
2. Applicant's submission of references on form PTO-1449, filed February 2, 2004, has been considered. A signed copy of the form is attached.

***Specification***

3. The disclosure is objected to because of the following informalities:

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors, i.e. grammar and spelling. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- The limitation of "an evaluation target design change input means" is present in claims 1 and 5, a correlation between this "evaluation...input means" and the remainder of the features of the instant invention is not clear. There appears to be no nexus between this means and the other limitations of the instant invention
- With regard to the "design change evaluation delivery means" of claim 1, it is not clearly apparent where the evaluation is to be delivered.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,871,182 B1 to Winnard et al.

The patented invention to Winnard et al. (hereinafter "Winnard") teaches of an engineering change decision analysis system and method. In doing so, the disclosure teaches and suggests the limitations of the instant invention.

With regard to the limitations of instant claims 1 and 5, the use of a case input means for inputting design changes is taught at column 2, lines 13-29. The system of prior art includes a graphical user interface operating on a computer and receives a selection for design change. The GUI continues by prompting the user for specific information necessary for analysis (col.3: ll. 9-11). The use of a database for storing inputted data is inherent to the system as disclosed by Winnard. However, figure 4 of the reference depicts the presence of computing devices which include memory for information storage or accumulation. The use of an evaluation target design change input means for inputting the updated contents is undertaken by the analysis system that prompts the user for pertinent analysis data, see col. 6: ll.11, et seq. As per the delivery means in claims 1, 3, and 4, Winnard teaches the relaying/displaying of a suggestion report which shows the preferred design choice, see col. 6: ll. 23-33. The displaying of a relationship between factors as per the final element of instant claim 5, is taught by the patented invention where the GUI displays data fields for the user to view either as a one-way analysis or a two-way analysis. These analyses show values of the variables either one at a time or two variables simultaneously. See column 6, lines 58-61.

The influential factors that are listed in instant claim 2 is detailed in the reference of prior art at column 3, beginning at line 13. Wherein, Winnard states that questions are posed to the user as a means of evaluating the factors relating to the change in design. The factors that are listed by Winnard, include cost, customer satisfaction, feasibility, management directives, missed objectives, and quality; which are similar to the influential factors of the instant invention.

For the reasons stated above in, the limitations of the claimed invention is taught by the prior art of record; thereby, rendering the instant claims unpatentable.

### **Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.. Applicant is advised to carefully review the cited art, as evidence of the state of the art, in preparation for responding to this Office action.

Li et al.	USPN 6,778,870 B1 teaches a design evaluation system
Sugino et al.	USPN 5,287,284 teaches a product specification analysis system that decides optimum values based on specifications.
Rose et al.	Patent Publication No. US 2005/0021314 A1 teaches of a method and apparatus for updating a design knowledge base.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela Rao whose telephone number is (571) 272-3751. The examiner can normally be reached Monday - Friday from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (571) 272-3749. The fax number for the organization where this application or any proceeding papers is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. It should be noted that status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should any questions arise regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Art Unit 2125